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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 09/548,465 | 04/13/2000 | Robert F. Bencini | 15916-261 | 7431 |
| 7590 07/20/2004 Henricks Slavin & Holmes LLP 840 Apollo Street Suite 200 El Segundo, CA 90245 | | | EXAMINER SIRMONS, KEVIN C | |
| | | | ART UNIT 3763 | PAPER NUMBER |

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/548,465

Applicant(s)

BENCINI ET AL. CC

Examiner

Kevin C. Simons

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3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 43-64 is/are pending in the application.
- 4a) Of the above claim(s) 3, 6-10 and 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 11, 17-26, 43-45 and 47-64 is/are rejected.
- 7) ☒ Claim(s) 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4, 5, 11, 17-26, 43-45 and 47-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Webster, Jr. U.S. Pat. No. 5,431,168.

Webster discloses an elongate body (10); a steering wire (36); a stiffening member (15, 21, and 51 are all regarded as a stiffening member since applicant has provided no structure for the limitation); a handle (fig. 8 and see handle throughout specification); as to claim 2, (see above rejection and (20)); as to claim 4, (51); as to claim 5, (15); as to claim 11, (51); as to claim 17, (fig. 1); as to claim 18, (see above rejections); as to claim 19, (fig. 1); as to claim 20 (see above rejections and anchoring member (31)); as to claim 21, (portion of the weld are made from stainless steel, therefore, a portion of the anchoring member is substantially radiopaque); as to claim 22, (figs. 1 and 4); as to claim 23, (fig. 4 and (51)); as to claim 24, (see above rejections and (15 and/or 38, note: anti-tear device has no structure and is not connected to anything); as to claim 25, (19); as to claim 26, (col. 6 addresses diagnostic element and therapeutic element); as to claim 43, (fig. 1 and 4); as to claim 44, (19); as to claim 46, see distal end of (figs. 1 and 4); as to claim 45, (19) as to claim 47; elongate body (10); a stiffening member (48, 51); an anti-tear device (21 and/or 49); a steering wire (36); note: All parts of the catheter are associated with one

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another, therefore the anti-tear device is associated with the stiffening member; as to claim 48, (49); as to claim 49,


an elongate body, (10); a steering wire (36); a stiffening member (19); an anti-tear device (21, 38 and 51); as to claim 50, (21, 38 and 51); as to claims 51 and 52, an elongate body (10); a stiffening member (19) a tubular member (38) and a steering wire (36); as to claim 53, (48, 51); as to claim 54, (21 and/or 49); as to claims 55-63, (see above rejections); as to claim 64, an elongate body (10); a stiffening member (38); anti-tear means (15) and a steering wire (36).

Allowable Subject Matter

Claim 46 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kevin C. Sirmons whose telephone number is (703) 306-5410. The examiner can normally be reached on Monday - Thursday from 6:30 am to 4:00 pm. The examiner can also be reached on alternate Fridays.


Kevin C. Sirmons
Patent Examiner
7/12/04